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EXAMINER

GANEY, STEVEN J

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD BODEN and CRAIG STUMPF

Appeal 2008-2977
Application 10/738,323
Technology Center 3700

Decided: December 23, 2008

Before WILLIAM F. PATE, III, JOHN C. KERINS, and STEFAN
STAICOVICI *Administrative Patent Judges*.

KERINS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Richard Boden and Craig Stumpf (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1 and 3-7, the only claims now pending in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE.

THE INVENTION

Appellants' claimed invention is to a dispensing device comprising a reservoir for storing an active gel, the reservoir having a wick with two ends, one to contact and convey the active gel by capillary action from one end of the wick to the other, and an emanator in physical contact with the end of the wick opposite the reservoir. The active gel stored in the reservoir comprises an oil or fragrance making up about 90 to 99.8% by weight of the active gel. (Appeal Br., Claims Appendix, claim 1).

Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A dispensing device comprising

a reservoir for storing an active gel comprising an oil or fragrance present in the active gel at about 90 to 99.8 percent by weight ;

a wick with two ends wherein one end contacts the active gel and conveys by capillary action said active gel to the opposite end of the wick; and

an emanator which is in physical contact with the end of the wick opposite the reservoir, wherein the emanator diffuses the active gel into the ambient atmosphere by the process of evaporation.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Orson	US 5,081,104	Jan. 14, 1992
Wefler	US 5,903,710	May 11, 1999

The following rejections are before us for review:

The Examiner has rejected claims 1 and 3-7 under 35 U.S.C. § 103(a) as being unpatentable over Wefler in view of Orson, and under 35 U.S.C. § 102(b) as being anticipated by Orson.

ISSUES

The Examiner contends that the claim language directed to the claimed reservoir being “for storing an active gel”, and directed to the gel composition, are only an intended use of the dispensing device and are not to be given patentable weight, or, in the alternative, that providing an active gel of the composition set forth in the claims amounts to an obvious discovery of the optimum or workable range of the oil or fragrance concentration in the gel.

Appellants urge that the claim language calling for an active gel having an oil or fragrance level of between about 90-99.8 percent by weight is not disclosed or suggested in the prior art cited by the Examiner, and that the claimed active gel is not an obvious variant of the prior art fragrance compositions obtained through an optimization exercise.

The issues joined in this appeal are: whether the claim language referencing the active gel and its composition is to be given patentable weight, and, if so, whether those claim elements are disclosed or rendered obvious by the cited prior art?

FINDINGS OF FACT

The following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

FF 1. The Orson patent discloses that the reservoir used therein to store a fragrance-containing gel may be made of polyvinyl chloride (PVC), resins, polyolefins (LDPE, HDPE), polyester (*e.g.*, PET), and phenolic resins. (Orson, col. 7, ll. 2-7).

FF 2. Each of the materials noted above may be described as either a “plastic” or a “flexible polymer”, or both.

FF 3. The Orson patent does not disclose a dispensing device having an active gel stored therein, in which the active gel comprises an oil or fragrance constituting 90 to 99.8 percent by weight of the active gel.

FF 4. The Orson patent discloses dispenser configurations in which an emanator is attached to a wick, and in which a heating element to aid in dispersion of the fragrance composition is provided as well. (Orson, col. 6, ll. 41-52).

FF 5. The Wefler patent does not disclose any specific fragrance-containing compositions, in terms of the concentrations of any of the ingredients or contents.

FF 6. The Orson patent discloses that fragrance-containing compositions having as high as 30% by weight fragrance can effectively be used in fragrance dispensers. (Orson, col. 3, l. 66-col. 4, ll. 10).

FF 7. The Orson fragrance compositions include a substantial amount of MMB or MMBE (known as a solvent) to solubilize the fragrance, rendering the composition homogenous and clear, and to control its evaporation rate. (Orson, col. 4, ll. 9-18).

FF 8. In all specific examples disclosed in Orson, the MMB concentration is considerably higher than the fragrance concentration. (Orson, Table 1, *passim*).

FF 9. One specific example given in the Orson patent is a composition containing 20% fragrance, 65% MMB and 15% water. (Orson, col. 4, ll. 55-57).

FF 10. Orson provides further general guidance to the effect that, for more concentrated (higher fragrance concentration) solutions, higher MMB levels are to be used (Orson, col. 4, ll. 54-55).

PRINCIPLES OF LAW

Anticipation (unpatentability under 35 U.S.C. § 102) is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. *RCA Corp. v. Applied Digital Data Sys., Inc.*, 730 F.2d 1440, 1444 (Fed. Cir. 1984).

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of

underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

Reliance on *per se* rules in determining obviousness is looked upon with disfavor by the Federal Circuit. *See, In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995).

Preamble language that merely states the purpose or intended use of an invention is also generally not treated as limiting the scope of the claim. *See Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339 (Fed. Cir. 2003). However, the preamble may be regarded as being more than a mere statement of intended use when it gives “life and meaning” to recitations in the body of the claim. *In re Szajna*, 422 F.2d 443 (CCPA 1970)(preamble reciting, “[A]n insert for converting a mold having a smooth molding surface” held to positively limit scope of claim where claim later referred to presence of a mold and molded surface).

ANALYSIS

Appellants argue all claims as a single group in addressing each rejection, and do not argue for the separate patentability of any claim or claims. We select claim 1 as representative of the group.

Anticipation Rejection under 35 U.S.C. § 102(b)

The Examiner cites to the Orson patent, finding that the patent discloses a dispensing device including a reservoir for storing a fragrance-

containing active gel, a wick with two ends to convey an active gel, one end of the wick being in contact with the active gel, and the other end being in physical contact with an emanator (diffusion aid). (Answer 5). The Examiner states that the claim language, “for storing an active gel comprising an oil or fragrance present in the active gel at about 90 to 99.8 percent by weight” (Appeal Br., Claims Appendix), is a “statement of intended use”. (Answer 5). The Examiner then finds that the Orson reservoir is capable of storing an active gel of the recited composition, and is thus capable of performing Appellants’ intended use. (*Id.*). The Examiner asserts that claim 1 is therefore fully anticipated. (*Id.*).

Appellants contend that the Orson patent does not teach or suggest an active gel comprising an oil or fragrance present in the active gel in a range of about 90 to 99.8 percent by weight of the gel, and that Orson does not teach or suggest the essential features of a reservoir for containing an active gel of such composition, or how to modify the Orson reservoir to contain such a gel. (Reply Br. 6).

Appellants’ latter contention is not persuasive. Appellants’ only stated criteria for the reservoir is that it be of a material that is impermeable and that is compatible with the active gel. (Specification, p. 7, ll. 7-8). Appellants paint with a broad brush in noting that “plastic, glass, flexible polymeric materials and metal” are all suitable materials. (Specification, p. 7, ll. 3-4). Orson discloses that its fragrance composition reservoir may suitably be made from polyvinyl chloride (PVC), resins, polyolefins (LDPE, HDPE), polyester (*e.g.*, PET), and phenolic resins. (FF 1). Each of these materials falls within the description of either or both of Appellants’ disclosed “plastic” and “flexible polymer” materials suitable for use. (FF 2).

The claimed reservoir for storing an active gel is fully met by the Orson reference.

Appellants' former contention joins the issue as to whether claim 1 should be construed as actually requiring the presence of an active gel in the claimed dispenser device, or whether, as asserted by the Examiner, the language directed to the active gel is nothing more than a statement of intended use. In that event, an anticipation rejection is proper upon establishing that the prior art device is capable of achieving the intended use, even if the prior art does not disclose using the specific active gel.

Standing alone, the claim language, "for storing an active gel comprising an oil or fragrance present in the active gel at about 90 to 99.8 percent by weight" might well be regarded as language directed to an intended use, the position urged by the Examiner. However, claim 1 further calls for the presence of a wick having two ends, "wherein one end *contacts the active gel* and *conveys [the active gel]* by capillary action...to the opposite end of the wick", and an emanator that "*diffuses the active gel* into the ambient atmosphere". (Appeal Br., Claims Appendix)(emphasis added). This language¹ evidences that actual contact between the gel and the wick, conveyance of the gel through the wick, and diffusion of the gel into the atmosphere, are required elements of the claimed invention. Such elements can be present only if the active gel is present. Further, since claim 1 positively recites the presence of an active gel in the dispensing device, the composition of the active gel (having oil or fragrance making up 90 to 99.8

¹ As compared to language that reads, for example, "wherein one end [contacts the] *is adapted to contact an* active gel, and [conveys the] *is adapted to convey by* capillary action [the] *an* active gel to the opposite end of the wick...", which could also be regarded as language of intended use.

weight percent thereof) is a tangible element of the claimed invention that must be taken into account in assessing the viability of the anticipation rejection.

Appellants are correct that the Orson patent does not disclose a dispensing device having an active gel stored therein, in which the active gel comprises an oil or fragrance constituting 90 to 99.8 percent by weight of the active gel, as set forth in claim 1. (FF 3). The Examiner does not contest this. Accordingly, the rejection of claim 1 as anticipated by Orson will not be sustained. Claims 3-7 depend from claim 1, and the rejection of those claims likewise will not be sustained.

Obviousness rejection under 35 U.S.C. § 103(a)

The Examiner concludes that it would have been obvious to modify the dispensing device of Wefler, which employs a wick with no emanator in contact with the wick at its terminal end, to add an emanator as disclosed in Orson, in order to facilitate diffusion of the oil or fragrance into the surrounding atmosphere. (Answer 4). The Examiner further concludes, as was the case in the anticipation rejection discussed above, that the claim language directed to the active gel and its composition are statements of intended use, and that the Wefler device is capable of being used to dispense such an active gel.² (*Id.*). The Examiner alternatively concludes, citing to *In re Aller*, 220 F.2d 454 (CCPA 1955), that it would have been obvious to provide an active gel having the claimed oil or fragrance content, “since it has been held that where the general conditions of a claim are disclosed in

² This interpretation of claim 1 was found to be erroneous in the analysis of the anticipation rejection above, and will not be addressed separately here.

the prior art, discovering the optimum or workable ranges involves only routine skill in the art.” (Answer 4).

Appellants urge that the modification to the Wefler device to add the emanator would not have been obvious because Wefler employs a heating element to aid in diffusing a fragrance composition instead of an emanator, and therefore Wefler has addressed the dispersion aspect using a different approach. (Appeal Br. 6-8, Reply Br. 4-5). Appellants also counter the alleged obviousness of the composition of the active gel, by noting that the claimed range of oil or fragrance concentration is much higher than that disclosed in the cited prior art, and that the prior art provides no direction or guidance that would lead one skilled in the art to arrive at the claimed composition through an optimization exercise. (Appeal Br. 4-5).

Appellants’ arguments directed to the proposed modification to the physical structure of the dispenser device are not persuasive. The Examiner points out that the Orson patent teaches the use of an emanator attached to a wick in configurations both in which a heating element is used, as well as in which a heating element is not used. (Answer 6; Orson, col. 6, ll. 41-52). Orson thus evidences that it was known to employ a dispensing device having both an emanator and a heating device. (FF 4).

The provision of an emanator on the Wefler device, which, as Appellants correctly note, employs a heating element to aid in dispersion, amounts to nothing more than the combination of known elements with no change in their respective functions to yield the predictable result (per Orson) of having both the heating element and emanator contribute to the diffusion of the fragrance composition. Such a combination would have

been obvious to a person of ordinary skill in the art. *See, KSR* 127 S.Ct. at 1739.

Turning to the claim element related to the composition of the active gel, the Examiner acknowledges that neither the Wefler patent nor the Orson patent discloses an active gel having the claimed oil or fragrance concentration. The Examiner, without citing to any evidence and without providing any reasoning (much less any sound reasoning), simply concludes that the claimed active gel composition would have been arrived at, applying only routine skill in the art, through an exercise in optimizing or determining the working ranges for the fragrance to be dispensed by the Wefler/Orson device.

The Examiner uses the *Aller* case as a crutch to support his conclusion, yet fails to demonstrate how the facts and evidence presented in this specific case compel the same outcome as in *Aller*. This treads perilously close to reliance on a *per se* rule of obviousness, a practice that is looked upon with disfavor by our reviewing court. *Ochiai*, 71 F.3d at 1572.

Indeed, the Examiner misapplies the principle set forth in *Aller*. There, the Court counseled that *if* one skilled in the art can discover the optimum or workable ranges *by routine experimentation*, where the general conditions of a claim are disclosed in the prior art, the differences between the claimed invention and the prior art may not be patentable differences. *Aller*, 220 F.2d at 827 (citing *In re Swain*, 156 F.2d 239 (CCPA 1946)). Rather than attempting to make a showing here that only routine experimentation would be involved in an optimization exercise directed to the fragrance composition, the Examiner instead turns the *Aller* principle on its head, removing the “routine experimentation” factor from the

prerequisites that must be established, and inserting “use of routine skill” as a part of the conclusion that is purportedly reached upon establishing that the prior art teaches the “general conditions” of the claimed invention.

Appellants more rigorously address the differences between the claimed composition and the prior art, and persuasively argue that there is a very substantial difference in the concentration of oil or fragrance in the active gel as claimed (90-99.8% by weight), and that in the fragrance compositions in the cited art. The Wefler patent does not disclose any specific oil or fragrance concentrations in the composition discussed therein. (FF 5). The Orson patent, in discussing improvements over other prior art dispensers and fragrance compositions (having one to ten percent by weight of actual fragrance included), notes that, with its compositions, fragrance levels as high as 30% can effectively be used. (FF 6).

Notably, as pointed out by Appellants, the Orson fragrance compositions include a substantial amount of MMB or MMBE (known as a solvent) to solubilize the fragrance, rendering the composition homogenous and clear, and to control its evaporation rate. (FF 7). In all specific examples disclosed, the MMB concentration is considerably higher than the fragrance concentration. (FF 8). One example given is a composition containing 20% fragrance, 65% MMB and 15% water. (FF 9). Considering further the general guidance in Orson that, for more concentrated (higher fragrance concentration) solutions, somewhat higher MMB levels are to be used (FF 10), it is difficult to fathom how the person of ordinary skill in the art, whether through optimization attempts or otherwise, would routinely proceed to a composition having 90% to 99.8% oil or fragrance. Such a

composition would have little to no MMB included therein, apparently directly contrary to the teachings of Orson.³

The Examiner's conclusion that the composition of the active gel as set forth in claim 1 would have been obvious can not be sustained based upon the evidence and reasoning of record. The rejection of claims 3-7, which depend from claim 1, also will not be sustained.

CONCLUSION

Appellants have established that reversible error exists in the rejection of claims 1 and 3-7 under 35 U.S.C. § 103(a) as unpatentable over Wefler in view of Orson, and in the rejection of those claims under 35 U.S.C. § 102(b) in view of Orson.

ORDER

The decision of the Examiner to reject claims 1 and 3-7 is reversed.

REVERSED

³ This further evidences the inapplicability of the *Aller* case to the facts at hand. The principle set forth in *Aller* is premised on the prior art disclosing the "general conditions" of the claimed invention. The discussion above makes clear that the Orson patent falls considerably short of disclosing the "general conditions" of the claimed active gel composition.

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